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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,541	01/21/2004	Peter Laczko	14878.0001	8640

7590 08/01/2005

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EXAMINER	
IP, SIKYIN	

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/760,541	LACZKO, PETER	
	Examiner	Art Unit	
	Sikyin Ip	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 3/28/05;5/10/05.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) 13-15 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12,16 and 17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 02/0105.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12, 16, and 17 are, drawn to an alloy steel composition, classified in class 420, subclass 9+.

II. Claims 13-15 are, drawn to a method of producing a metal composed of the alloy steel , classified in class 148, subclass 540+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as references cited below in the rejections.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicant's election of Group I in the reply filed on March 28, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the

supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 6375763 to Yokoyama et al (composition and pearlite microstructure: col. 1, line 45 to col. 2, line 47; hardness: col. 3, lines 18-35, and Table 2).

Claims 1-4, 6-8, 12, 16, and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 2001059128 (composition and hardness: abstract).

Claims 1-4, 8, and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over CN 1278563 (abstract), JP 2001294972 (abstract), JP 2002161334 (abstract), CN

1360082 (abstract), or JP 2002275584 (abstract). (All disclose the claimed alloy steel composition).

Claims 1-5, 8, and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5922145 to Watari et al (composition and pearlite structure: paragraph bridging col. 2-3 and col. 3, lines 50-57).

Claims 1-8, 12, 16, and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 2000345296 (abstract)

Cited references disclose the features including the claimed alloy steel composition and features as set forth above. Therefore, when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. As stated in In re Peterson, 65 USPQ2d 1379, 1382 (CAFC 2003), that "A prima facie case of obviousness typically exists when

the ranges of a claimed composition overlap the ranges disclosed in the prior art." Also see MPEP § 2131.03 and § 2123.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000345296, USP 6375763 to Yokoyama et al or USP 5922145 to Watari et al as applied to claims above, and further in view of acknowledged prior art admission in page 1, lines 9-29.

Yokoyama or Watari reference discloses the features substantially as claimed as set forth in the rejection above except for using the alloy steel composition for autogenous grinding mills. However, acknowledged prior art admission discloses metal castings as of cited references are known for autogenous grinding mills parts in the same field of endeavor or the analogous metallurgical art. The use of conventional materials to perform their known functions in a conventional process is obvious. In re Raner, 134 USPQ 343 (CCPA 1962).

Response to Arguments

Applicant's arguments filed March 28, 2005 have been fully considered but they are not persuasive.

Applicant argues that examiner failed to provide any motivation to alter the compositions of cited references. Applicant's attention is directed to the case law and MPEP as cited in rejection above that "A prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the

prior art." See In re Peterson, 65 USPQ2d 1379, 1382 (CAFC 2003), also see MPEP § 2131.03 and § 2123.

Applicant's argument with respect to instant claims 9-11 in page 9/10 of instant remarks is noted. Applicant's attention is directed to Yokoyama (composition and pearlite microstructure: col. 1, line 45 to col. 2, line 47; hardness: col. 3, lines 18-35, and Table 2) and Watari al (composition and pearlite structure: paragraph bridging col. 2-3 and col. 3, lines 50-57).

Applicant's argument in paragraph bridging pages 9-10 of instant remarks is noted. But, the instant transitional expression "includes" in claim 1, line 1, for example, which is inclusive and fails to exclude unrecited ingredients even in major amounts. See Ex parte Davis et al. (POBA 1948) 80 USPQ 448 and In re Bertsch 132 F2d 1014, 56 USPQ 379 (CCPA 1942).

Information Disclosure Statement

The references such as USP 5055253, SU 1627582, CN 1332264, CN 1100150, CS 244160, SU 1025750, and JP 2002-069578 recited in instant IDS are considered as cumulative references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been meet by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
July 24, 2005